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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86356569
Applicant	Kipling Apparel Corp.
Applied for Mark	KIPLING
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Date	06/20/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of : **Kipling Apparel Corp.**	:	
Mark: KIPLING	:	**Trademark Examining Attorney:** **Priscilla Milton** **Law Office 110**
Serial No.: 86/356,569	:	
Filed: August 4, 2014	:	

APPLICANT'S REPLY BRIEF

This is a reply to the Trademark Examining Attorney's June 1, 2016 brief for refusing to register the mark KIPLING (Application Serial Number 86/356,569) for the following International Class 20 goods: Picture Frames, and the following International Class 21 goods: Mugs, tumblers, drinking bottles; trays for domestic purposes; coasters not of paper and other than table linen; leather coasters, plastic coasters.

The Examining Attorney, in her brief, merely rehashes the prior arguments filed on this matter, ignores Applicant's substantial arguments, and disregards TTAB precedent that a dispute about whether a mark is primarily merely a surname should be decided in deference to the Applicant. Therefore, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal and allow the mark to be registered.

TABLE OF AUTHORITIES

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I. ARGUMENT

A. KIPLING is not primarily merely a surname.

1. 363 appearances evidences Kipling as an Extremely Rare Surname

The Trademark Examining Attorney has repeatedly rejected Applicant's argument that KIPLING is an extremely rare surname, and does so again in her brief. *See Examiner's Brief, pages 5-6.* However, Applicant respectfully submits that the Trademark Examining Attorney's evidence of 363 listings is insufficient to demonstrate that KIPLING is not a rare surname. In fact, the evidence is to the contrary and should not be ignored. There are numerous cases which have concluded that a surname is deemed rare even though there are many listings for the surname. *See, e.g., In re Okamoto Corp.*, 2015 LEXIS 301 (TTAB 2015) (reversing a refusal to register OKAMOTO, the Examining Attorney's submission of 739 Lexis listings for the surname "Okamoto" and 33 Internet excerpts referencing others with that surname was deemed insufficient in showing that the surname is not rare); *In re GR Lane Health Products Limited*, Serial No. 85/115,445 (July 10, 2013) [not precedential] (JAKEMANS for throat lozenges and candies not primarily merely a surname despite evidence of 2,365 Jakemans in nationwide directory); *In re Joint-Stock Company "Baik"*, 84 USPQ2d 1921 (TTAB 2007) (holding that BAIK is an extremely rare surname based on the fact that only 456 listings of the surname were found); and *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER rare surname despite 1,295 telephone directory listings).

The foregoing cases clearly establish that the Trademark Office will indeed objectively evaluate the quantity of evidence supporting the rarity of a surname. Even on a case-by-case basis, if the Trademark Office has refused evidence that a surname was not rare based on up to at least 2,365 listings of a particular surname, clearly, the Trademark Examining Attorney's combined evidence of 363 entries for the surname KIPLING is insufficient evidence that the

surname is not extremely rare here. Although the quantum of evidence necessary to support a rarity argument varies, the situation where only 9 out of every 50 million people share the surname "Kipling" should be convincing evidence that the surname is extremely rare and its primary significance to purchasers is not that of a surname. In the face of such evidence, the Examining Attorney's embrace of a "look and feel" approach to substantiate her contrary conclusion is unsupported.

2. The Examining Attorney's arguments concerning the sufficiency of Applicant's evidence ignores the purpose of that evidence

The Examining Attorney attempts to undercut the sufficiency of the evidence Applicant has previously provided, particularly with regards to the Google searches listed as Exhibit E in the First Office Action response. *Examiner's Brief, page 8.* However, the Examiner misses the point as to why the evidence was presented and what it clearly shows: the Google searches results, which each provide two lines of underlying text to show the search term in context, show that each and every time KIPLING appears in reference to a person, the person referenced is the famous author Rudyard Kipling. KIPLING is only evocative of one particular famous individual, rather than numerous individuals, which demonstrates that KIPLING exclusively refers to a famous historical person, and is not primarily merely a surname. *See TMEP §1211.01(a)(v)* (citing *In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, 1290 (TTAB 2007). Copies of the actual pages described in the Google search results are not needed to provide any additional context.

3. The Examining Attorney ignores TTAB precedent

Ultimately, the Examining Attorney fails to address fundamental TTAB precedent: "If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant." *TMEP* §1211.01 (citing *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); *In re Benthin Mgmt. GmgH*, 37 USPQ2d 1332, 1334 (TTAB 1995)). Applicant maintains that there is no doubt that the KIPLING mark is not primarily merely a surname, and has demonstrated in its filings that, to the extent any doubt exists, precedent dictates that this Board overturn the Trademark Examining Attorney's refusal to register the mark in Applicant's favor.

B. Alternatively, even assuming KIPLING is Primarily Merely a Surname, the Mark has Acquired Distinctiveness under Section 2(f) Due to Applicant's Prior Registrations for the Same and Similar Marks for Related Goods

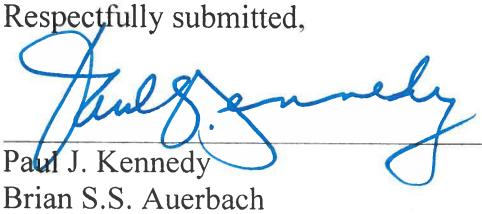
The Examining Attorney agrees with Applicant that U.S. Registration Nos. 4537944 and 2945417 are identical to the mark in the current application and thus meet the legal equivalence test. *See Examiner's Brief, page 13.* However, the Examining Attorney incorrectly states that the Applicant has not provided any explanation as to how the goods and/or services in the prior registrations are similar or related to the good and/or services in the present application, when in fact Applicant has provided such an argument on multiple occasions. *See Second Office Action Response, pages 7 and 8; Applicant's Appeal Brief, pages 11 and 12.* The Examining Attorney's Brief has merely re-asserted that relatedness of the goods and/or services is not self-evident, but has put forth no rebuttal of Applicant's substantive argument, even when presented with several opportunities to do so.

It is clear that KIPLING is not primarily merely a surname and thus registrable on the Principal Register. To the extent any doubt exists, Applicant respectfully requests this Board rule in Applicant's favor. Alternatively, moreover, Applicant has repeatedly demonstrated that

the mark has acquired distinctiveness under Section 2(f) due to Applicant's prior registrations for the same and similar marks for related goods.

For these reasons, Applicant respectfully requests that this Board overturn the Office Actions of the Trademark Examining Attorney and allow its Application on the Principal Register.

Respectfully submitted,



DATE: June 20, 2016

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